

REMARKS

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority under 35 U.S.C. § 119, and receipt of the priority document filed July 8, 2005; for initialing and returning the PTO SB/08 Forms submitted with the Information Disclosure Statements of July 8, 2005; and indicating acceptance of the drawings filed on July 8, 2005.

DETAILED ACTION

Claim Rejections - 35 USC § 102

Claims 1, 7-11, 17-21, 27-31, and 37-40 are rejected under 35 U.S.C. 102(e) as being allegedly anticipated by Sinnarajah (U.S. Pub. No.: 2004/0203336). Applicant respectfully traverses these rejections.

Claims 1, 11, 21, and 31

By this Amendment, Applicant has amended claim 1. A feature of independent claim 1 now recites, in part, "based on a transmission distribution power of the communication data content to one of the at least one mobile station". The Examiner maintains that this feature is disclosed by Sinnarajah. Applicant respectfully disagrees with the Examiner's position.

The Examiner asserts that paragraph [0079], FIG. 6, and FIG. 16 of Sinnarajah discloses the above recited feature. Sinnarajah, however, is directed to the power provided to *all of the subscriber-stations* demanding a particular broadcast program from the base station, and the resultant change in the power requirement for all of the subscriber-stations (paragraph [0080], lines 1-3) but does not disclose the power requirement for individual subscriber stations. As a result, if the *total* subscriber-station power usage is over a predetermined threshold, then the base station will change the broadcast communication channel for all subscriber-station power usage (paragraph [0080], lines 7-11) rather than an individual subscriber-station. Thus, Applicant

respectfully submits that Sinnarajah does not disclose or suggest, “based on a transmission distribution power of the communication data content to one of the at least one mobile station”.

Since the Examiner has not established that the applied reference includes each and every feature of the claimed invention, the Sinnarajah reference is not properly a § 102 reference. Thus, claim 1 should be patentable over the applied art. Furthermore, for the same reasons that claim 1 is patentable over the prior art, claims 11, 21, and 31 are also patentable over the prior art.

Accordingly, claims 2-10, 12-20, 22-30, and 32-40 should be patentable at least by virtue of their dependencies from claims 1, 11, 21, and 31 respectively.

Claims 7, 17, 27, and 37

Claims 7, 17, 27 and 37 are dependent upon independent claims 1, 11, 21, and 31 respectively. Accordingly, claims 7, 17, 27 and 37 are patentable at least by virtue of their dependencies.

By this Amendment, Applicant has amended claims 7, 17, 27, and 37. A feature of claims 7, 17, 27 and 37 now recites, in part, “bases the determination on a *total number* of the at least one mobile station”. The Examiner maintains that this feature is disclosed by Sinnarajah. Applicant respectfully disagrees with the Examiner’s position.

The Examiner asserts that:

the subject base station experiences a change in the number of subscriber-stations demanding a particular broadcast program from that base station...Thus, switching to use of a shared communications channel (see paragraph [0080], lines 1-13)

as disclosing the feature, “bases the determination on a total number of the at least one mobile station” as recited in the claimed invention. In Sinnarajah, however, the switching is based on

changes in the number of subscriber stations. Thus, Sinnarajah does not teach or suggest the feature of “bases the determination on a total number of the at least one mobile station” as recited in the claimed invention.

Claims 8, 18, 28, and 38

Claims 8, 18, 28, and 38 are dependent upon independent claims 1, 11, 21, and 31 respectively. Accordingly, claims 8, 18, 28, and 38 are patentable at least by virtue of their dependencies.

By this Amendment, Applicant has amended claims 8, 18, 28, and 38. A feature of claims 8, 18, 28, and 38 now recite, in part, “bases the determination on an allowable number of the at least one mobile station”. The Examiner maintains that this feature is disclosed by Sinnarajah. Applicant respectfully disagrees with the Examiner’s position.

The Examiner asserts that paragraph [0079], FIG. 6, and FIG. 16 as disclosing the feature, “bases the determination on an allowable number of the at least one mobile station” as recited in the claimed invention. In Sinnarajah, however, the switching is based on *changes in the number* of subscriber stations. Thus, Sinnarajah does not teach or suggest the feature of “bases the determination on an allowable number of the at least one mobile station” as recited in the claimed invention.

Claims 9, 19, 29, and 39

Claims 9, 19, 29, and 39 are dependent upon independent claims 1, 11, 21, and 31 respectively. Accordingly, claims 9, 19, 29, and 39 are patentable at least by virtue of their dependencies.

By this Amendment, Applicant has amended claims 9, 19, 29, and 39. A feature of claims 9, 19, 29, and 39 now recite, in part, “bases the determination on an allowable number of

the at least one mobile station that receive services other than that of distribution of the communication data content”. The Examiner maintains that this feature is disclosed by Sinnarajah. Applicant respectfully disagrees with the Examiner’s position.

The Examiner asserts that paragraph [0079], FIG. 6, and FIG. 16 as disclosing the feature, “bases the determination on an allowable number of the at least one mobile station that receive services other than that of distribution of the communication data content” as recited in the claimed invention. In Sinnarajah, however, the switching is based on *changes in the number* of subscriber stations. Thus, Sinnarajah does not teach or suggest the feature of “bases the determination on an allowable number of the at least one mobile station that receive services other than that of distribution of the communication data content” as recited in the claimed invention.

Claims 10, 20, 30, and 40

Claims 10, 20, 30, and 40 are dependent upon independent claims 1, 11, 21, and 31 respectively. Accordingly, claims 10, 20, 30, and 40 are patentable at least by virtue of their dependencies.

Claim Rejections - 35 USC § 103

Claims 2-3, 12-13, 22-23, and 32-33 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Sinnarajah in view of Black (U.S. 6,594,501). Applicant respectfully traverses these rejections.

Claims 4, 14, 24, and 34 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Sinnarajah and Black and further in view of Hayakawa (U.S. Patent 6,708,042). Applicant respectfully traverses these rejections.

Claims 5-6, 15-16, 25-26, and 35-36 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Sinnarajah, Black, and Hayakawa further in view of Takano (U.S. Patent 6,934,556). Applicant respectfully traverses these rejections.

Claims 2, 12, 22, and 32

Claims 2, 12, 22, and 32 are dependent upon independent claims 1, 11, 21, and 31 respectively. Accordingly, claims 2, 12, 22, and 32 are patentable at least by virtue of their dependencies.

By this Amendment, Applicant has amended claims 2, 12, 22, and 32. A feature of claims 2, 12, 22, and 32 now recite, in part:

a first downlink transmission power of the individual communication channel and
a second downlink transmission power of the common communication channel.

The Examiner asserts:

a power control system that can be used to limit the transmission power over both
the forward and reverse links (See Black, col. 3, lines 49-56)
and

Black teaches the *concept* of the downlink transmission power of the first
communication channel and the downlink transmission power of the second
communication channel (col. 1, lines 55-60; FIG. 1; and FIG. 6)

as disclosing “a first downlink transmission power of the individual communication channel and
a second downlink transmission power of the common communication channel” as recited in
claims 2, 12, 22, and 32.

One of ordinary skill in the art, following the guidance found in the Black patent, however, would be led in a direction divergent from the path that was taken by the Applicant because the Black patent teaches away from the invention of claims 2, 12, 22, and 32. Since a reference which teaches away is a significant factor in determining obviousness, the nature of

that teaching is highly relevant and must be considered. See In re Gurley, 31 U.S.P.Q.2d 1130 (Fed. Cir. 1994). The Examiner's analysis gives no weight to the teachings in the applied reference which contradict the Examiner's position. This selective view of the Black patent allows the Examiner to focus on a first downlink transmission power of the individual communication channel and a second downlink transmission power of the common communication channel, while completely ignoring, for example, that the Black patent teaches away from the specifically recited *single use* of either the first or second channel. The Black prior art specifically teaches adjusting the power ratio of a first to second channel and the continual *dual use* of channels (col. 1, lines 54-61).

Furthermore, there is no motivation or suggestion for the Examiner's proposed combination of references. Applicant respectfully submits that one of ordinary skill in the art at the time of the presently-claimed invention would not have been motivated to combine Sinnarajah and Black as suggested by the Examiner because there is no suggestion of motivation for doing so in the references themselves or the knowledge available to one of ordinary skill in the art without resorting to impermissible hindsight. Sinnarajah teaches an apparatus and method for *switching between* shared and individual channels to provide broadcast content services. Alternatively, Black teaches a method and system for controlling transmission power ratio of a first and second channel. The Examiner proposes that it would be obvious to one of ordinary skill in the art "to provide a system (or network) or a method of controlling transmission power includes receiving a first to second channel power ratio, adjusting the power ratio if a combined power of a plurality of channels exceeds a threshold, the channels including the first and second channels, and computing gain of the first channel as a function of the power ratio so that to achieve a desire quality service as suggested". However, the method of Sinnarajah teaches

switching between the first and second channels. Therefore, in combination with the method of Black, the method of Sinnarajah relating to switching between a first and second channel would be meaningless because Black implements usage of both channels. Because of the disparity between these two references, the only possible motivation for the Examiner's proposed combination is Applicant's own disclosure, the reliance on which constitutes impermissible hindsight reconstruction under MPEP §2143 (see also *In re Vaeck*, 20 USPQ 1438 (Fed. Cir. 1991)).

Applicant respectfully submits that Black does not compensate for the deficiencies of Sinnarajah, and thus, Black and Sinnarajah, alone or in combination, do not teach or suggest all of the features of claims 2, 12, 22, and 32.

Claims 3, 13, 23, and 33

Claims 3, 13, 23, and 33 are dependent upon claims 2, 12, 22, and 32 respectively. Accordingly, claims 3, 13, 23, and 33 are patentable at least by virtue of their dependencies.

By this Amendment, Applicant has amended claims 3, 13, 23, and 33. Claims 3, 13, 23, and 33 now recites, in part, "the at least one type of communication channel is switched from the individual communication channel to the common communication channel when the second downlink transmission power is less than the first downlink transmission power". The Examiner maintains that these features are disclosed by Sinnarajah in view of Black. Applicant respectfully disagrees with the Examiner's position.

There is no motivation or suggestion for the Examiner's proposed combination of references. Applicant respectfully submits that one of ordinary skill in the art at the time of the presently-claimed invention would not have been motivated to combine Sinnarajah and Black as suggested by the Examiner because there is no suggestion of motivation for doing so in the

references themselves or the knowledge available to one of ordinary skill in the art without resorting to impermissible hindsight. Sinnarajah teaches an apparatus and method for *switching between* shared and individual channels to provide broadcast content services. Alternately, Black teaches a method and system for controlling transmission power ratio of a first and second channel. The Examiner proposes that the claimed invention would be obvious to one of ordinary skill in the art without providing a motivation to combine. Regardless, the method of Sinnarajah teaches switching between the first and second channels. Therefore, in combination with the method of Black, the method of Sinnarajah relating to switching between a first and second channel would be meaningless because Black implements usage of both channels. Because of the disparity between these two references, the only possible motivation for the Examiner's proposed combination is Applicant's own disclosure, the reliance on which constitutes impermissible hindsight reconstruction under MPEP §2143 (see also *In re Vaeck*, 20 USPQ 1438 (Fed. Cir. 1991)).

Applicant respectfully submits that Black does not compensate for the deficiencies of Sinnarajah, and thus, Black and Sinnarajah, alone or in combination, do not teach or suggest all of the features of claims 3, 13, 23, and 33.

Claims 4, 14, 24, and 34

Claims 4, 14, 24, and 34 are dependent upon claims 2, 12, 22, and 32 respectively. Accordingly, claims 4, 14, 24, and 34 are patentable at least by virtue of their dependencies.

By this Amendment, Applicant has amended claims 4, 14, 24, and 34. A feature of claim 4 now recites, in part, "as long as a total downlink transmission power of the base station during the channel switching from the individual communication channel to the common communication channel does not exceed an upper limit of a transmission power that the base

station can output to a cell". The Examiner maintains that this feature is disclosed by Sinnarajah and Black and further in view of Hayakawa. Applicant respectfully disagrees with the Examiner's position.

The Examiner asserts that col. 17, lines 31-37; and Steps 413-414 of Fig. 4 of Hayakawa discloses "as long as a total downlink transmission power of the base station during the channel switching from the individual communication channel to the common communication channel does not exceed an upper limit of a transmission power that the base station can output to a cell" as recited in claims 4, 14, 24, and 34. Hayakawa, however, discloses that "an actual transmitting power P_p to the mobile station may not exceed the upper limit P of transmitting power of the base station," but does not disclose or suggest that the, "as long as a total downlink transmission power of the base station *during the channel switching* from the individual communication channel to the common communication channel does not exceed an upper limit of a transmission power that the base station can output to a cell".

Applicant respectfully submits that Hayakawa does not compensate for the deficiencies of Black and Sinnarajah, and thus, Sinnarajah, Black, and Hayakawa, alone or in combination, do not teach or suggest all of the features of claim 4.

For the same reasons regarding the patentability of claim 4 over the prior art, claims 14, 24, and 34 are also patentable over the prior art.

Claims 5-6, 15-16, 25-26, and 35-36

Claims 5-6, 15-16, 25-26, and 35-36 are dependent upon claims 4, 14, 24, and 34 respectively. Accordingly, claims 5-6, 15-16, 25-26, and 35-36 are patentable at least by virtue of their dependencies.

By this Amendment, Applicant has amended claims 5-6, 15-16, 25-26, and 35-36. A feature of claim 5 now recites, in part, “the channel determination means *sequentially performs the channel switching* for the individual communication channel in an ascending order of the transmission power required to complete the channel switching from the individual communication channel to the common communication channel”. The Examiner maintains that this feature is disclosed by Sinnarajah, Black, and Hayakawa further in view of Takano. Applicant respectfully disagrees with the Examiner’s position.

The Examiner asserts that the “descending order, ascending order, and downlink transmission” of Takano (col. 7, lines 11-23 and lines 36-45) discloses, “the channel determination means *sequentially performs the channel switching* for the individual communication channel in an ascending order” as recited in claim 5. Takano, however, discloses that the threshold values are arranged in the ascending order of levels (col. 7, lines 21-23), but does not disclose or teach, “sequentially performs the channel switching” as recited in claim 5.

Applicant respectfully submits that Takano does not compensate for the deficiencies of Black, Sinnarajah, and Hayakawa; and thus, Sinnarajah, Black, Hayakawa, and Takano, alone or in combination, do not teach or suggest all of the features of claim 5.

For the same reasons regarding the patentability of claim 5 over the prior art, claims 6, 15-16, 25-26, and 35-36 are also patentable over the prior art.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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